

REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. § 1.116, and in light of the remarks which follow.

Entry of this Amendment is proper under 37 C.F.R. § 1.116 because the Amendment places the application into condition for allowance (for the reasons discussed herein), or places the application into better form for appeal, should an appeal be necessary. The Amendment does not raise the issue of new matter and does not raise issues requiring additional search and/or consideration since the Amendment is directed to subject matter previously considered during prosecution. The remarks presented below supplement those presented in Applicants' earlier responses and are presented here in further response to issues raised in the final rejection. Applicants respectfully request entry of the Amendment.

Applicants thank the Examiner for acknowledging Applicants' Amendment of February 23, 2009, and for entry and consideration of the amendments and remarks presented therein. For at least the reasons that follow, Applicants respectfully submit that all pending claims in the application are in condition for allowance.

Claims 10-17, 19-20 and 23 are pending in the application, claims 19 and 21 having been canceled above without prejudice or disclaimer, and new claim 23 having been added above.

By the above amendments, Applicants amended claim 10 to address the § 112 and § 101 issues raised in the Official Action and to further clarify the scope of the claimed method. Applicants also amended claims 14-17 to address minor informalities and canceled claims 19 and 21 without prejudice to or disclaimer of the

subject matter therein. Finally, Applicants added new claim 23 to further define an exemplary embodiment. Support for new claim 23 can be found at least at page 1, lines 5-12. A claim that has been amended in a manner that does not narrow the claim's scope should be accorded its full range of equivalents. No new matter has been added.

Turning now to the Official Action, claims 10-17 and 19-21 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. For at least the reasons that follow, withdrawal of the rejection is in order.

The Official Action rejected claims 10-17 and 19-20 under § 112 as being indefinite because the claims purportedly did not include particular steps. Claim 10, as amended above, now recites additional method steps including, for example, (i) preparing said adhesive composition by successively or simultaneously adding an isocyanate composition (a) and a surfactant (b) to an aqueous phase; (ii) applying said adhesive composition to at least one substrate; and (iii) bonding together at least two surfaces with said adhesive composition.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the § 112, second paragraph, rejection of claims 10-17 and 19-20.

Claims 10-17 and 19-20 stand rejected under 35 U.S.C. § 101 for use of an improper method claim format. For at least the reasons that follow, withdrawal of the rejection is in order.

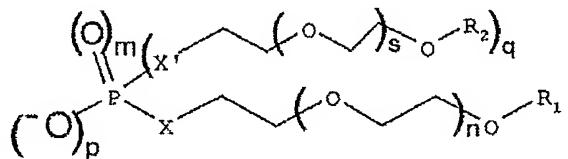
The Official Action rejects claims 10-17 and 19-20 under § 101 for purportedly not setting forth particular steps in the claimed process, which the Official Action asserts results in an improper definition of a process under § 101. As explained

above in response to the § 112, second paragraph, rejection, Applicants have amended claim 10 to recite, specific method, steps (i); (ii); and (iii).

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection of claims 10-17 and 19-20.

Claims 10-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nabavi (WO 97/31960). For at least the reasons that follow, withdrawal of the rejection is in order.

Claim 10, as amended above, recites a method of using an adhesive composition, said method comprising the steps of (i) preparing said adhesive composition by successively or simultaneously adding, an isocyanate composition (a) and a surfactant (b) to an aqueous phase having a pH of 4-9 and comprising an adhesive polymer, said isocyanate composition (a) with a mass content of N=C=O function of between 10% and 30%, and with a viscosity of not more than 2500 mPa.s, and said surfactant (b) comprising a compound or a mixture of compounds of mean general formula:



wherein p represents a value between 1 and 2; m represents zero or 1; the sum p+m+q is equal to 3; the sum 1+p+2m+q is equal to 3 or 5; X is an oxygen; X' is an oxygen; n and s have the same statistical value, chosen between 5 and 30, wherein R₁ and R₂, which are identical, represent an alkylaryl of 10 to 20 carbon atoms; (ii)

applying said adhesive composition to at least one substrate; and (iii) bonding together at least two surfaces with said adhesive composition. (Emphasis added.)

Nabavi relates to isocyanate-based compounds and compositions. It also relates to their process for utilization, their utilization for coating and coatings thus obtained. (See, Nabavi at col. 1, paragraph [0001].) In particular, Nabavi is directed to compositions for use in paints and varnishes. (See, Nabavi at col. 1, paragraph [0005].)

It is well-established that in order to demonstrate anticipation under § 102, each feature of the claim at issue must be found, either expressly described or under principles of inherency, in a single prior art reference. See *Kalman v. Kimberly-Clark Corp.*, 218 U.S.P.Q. 798 (Fed. Cir. 1983). That is not the case here.

In particular, as acknowledged by the Official Action, Nabavi does not disclose or fairly suggest the method of claim 10, as amended above, comprising the combination of features recited in claim 10. In particular, the method of claim 10 is not directed to coatings like Nabavi, but is instead directed to a method of using an adhesive composition comprising, *inter alia*, the steps of: (i) preparing said adhesive composition; (ii) applying said adhesive composition to at least one substrate; and (iii) bonding together at least two surfaces with said adhesive composition.

Accordingly, Nabavi cannot anticipate the method of claim 10 because it does not, expressly or inherently, describe each feature in the combination of features recited in independent claim 10.

For at least these reasons, Applicants respectfully submit that claim 10 is patentable over Nabavi. The remaining claims (claims 11-17 and 20-23) depend,

directly or indirectly, from claim 10 and are, therefore, also patentable over Nabavi for at least the reasons that claim 10 is patentable.

As a final matter, Applicants note that new, dependent claim 23 further defines the method of claim 10 by indicating that said substrate is wood or elastomer. Applicants respectfully submit that claim 23 is patentable over Nabavi for at least the reasons that claim 10 is patentable. That is, because claim 23 depends directly from claim 10, claim 23 necessarily includes all the features in the combination of features defined by claim 10. Moreover, claim 23 includes the further distinguishing feature that the substrate is wood or elastomer, which Nabavi also fails to expressly or inherently describe.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

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